

REMARKS

Claims 1-3, 6, 8-12, 15 and 17-26 are pending in this application. By this Amendment, claims 1 and 12 are amended to correct informalities. No new matter is added. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed below by satisfying a requirement of form asserted in the previous Office Action; and (b) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to assertions noted in the final rejection. Entry of the amendments is thus respectfully requested.

The Office Action, in paragraph 4, rejects claims 1 and 12 under 35 U.S.C. §112, second paragraph, for terms in those claims lacking antecedent basis. This rejection is respectfully traversed.

Claims 1 and 12 are amended to obviate the rejection. Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 12 under 35 U.S.C. §112, second paragraph, are respectfully requested.

The Office Action, in paragraph 6, rejects claims 1-26 under 35 U.S.C. §103(a) over U.S. Patent No. 5,999,932 to Paul in view of U.S. Patent Application Publication No. 2002/0116263 A1 to Gouge. Applicant understands this rejection to be directed to claims 1-3, 6, 8-12, 15 and 17-26, because the other claims were canceled in Applicant's response to a previous Office Action. This rejection is respectfully traversed.

Paul teaches a system for eliminating unsolicited electronic mail that generates and stores a user inclusion list including identification data for identifying e-mail desired by the user (Abstract). With reference to various disclosures in Paul, the Office Action alleges that

Paul teaches many of the features recited in the pending claims. The Office Action, however, concedes that Paul fails to specifically teach selecting those e-mail messages satisfying at least one condition from a conditional group as set forth in independent claims 1 and 12. The Office Action alleges that such a feature is well known as evidence by Gouge. The Office Action concludes that it would have been obvious to incorporate features taught by Gouge with the teachings of Paul "for the purpose of allowing a system to retrieving [SIC] user data profile to advertise a product, service or website n [SIC] which a [SIC] the user might be interested as stated by Gouge." The analysis of the Office Action in this regard fails for at least the following reasons.

Gouge teaches a very specific method by which information can be disseminated between users of a specific e-mail exchange system. With reference to, for example, Fig. 3 of Gouge, it is clear that the system of Gouge becomes involved in direct communications between two users. Of note, for example, in paragraph [0185] and below, Gouge looks at every e-mail. The decision in Gouge is which advertisement to associate with the outgoing e-mail not selecting which e-mails to review based on any criteria. The Office Action asserts that Gouge discloses a data processing center with means for a user created forwarding e-mail containing an attachment having first and second data. To any extent that this is what Gouge may reasonably be considered to teach, or to have suggested, Gouge represents, therefore, one of the types of systems discussed in the background section of Applicant's disclosure. In such systems, user intervention is required, or a user established profile, is provided, to identify specific interests. In this regard, Gouge suffers from the shortfall of the other related art discussed on, for example, page 2 of Applicant's disclosure which states that "(a)lthough flexible, in that users can instruct their mail client to look for specific words in the subject or content of the message, these approaches; (a) do not address the extraction of 'interest

profiles' from the content of the e-mail messages and (b) do rely on the recipients to explicitly set up and maintain the rules."

Claim 1 recites, among other features, monitoring e-mail messages directed to the user; and selecting those e-mail messages satisfying at least one condition from a conditional group of a message having an attachment, a message being a forwarded message and a message including a URL as indicators that individual ones of the e-mail messages are likely to include information relevant to the user's interests, and wherein, for each selected message, the selected messages selected and the extracted profile data is extracted before the user reads the selected message. To any extent that Gouge teaches, as the Office Action alleges, that Gouge references a user created forwarding e-mail containing an attachment, the disclosure of Gouge cannot be expanded in the manner suggested by the Office Action to encompass the subject matter of the pending claims. In other words, Gouge simply does not select those e-mail messages satisfying at least one condition from a conditional group, as recited in claim 1, and varyingly recited in claim 12.

The Office Action summarily concludes that it would have been obvious to combine Gouge with Paul. For the purpose of allowing a system to retrieve user data profile to advertise a product, service or website sighting paragraphs [0042]-[0046] of Gouge. This assertion interestingly paraphrases the actual disclosure of Gouge in attempting to support rendering obvious the subject matter of the pending claims. The cited paragraphs refer to referencing a database, not the e-mail, in an attempt to retrieve information and find an advertisement that may be related to that information, and not necessarily to a determination of a user interest based on the information. Gouge also refers to an application of several other factors including a time of day factor. To the extent that the objective noted by the Office Action is even an objective of the Gouge method, which it does not appear to be as stated in the Office Action, the

analysis of the Office Action regarding the combination of Paul with Gouge fails for at least the following reasons.

First, MPEP §2142 instructs that the proper standard by which to determine obviousness requires (1) that the Examiner step backward in time into the shoes of the hypothetical "person of ordinary skill in the art," (2) that "[i]n view of all the factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at the time to that person," and (3) that any knowledge gained from Applicant's disclosure must be put aside at reaching this determination in order to avoid the tendency to resort to the impermissible application of hindsight reasoning based on the roadmap provided by Applicant's disclosure. Clearly, there is nothing in Paul and/or Gouge to suggest that one of ordinary skill in the art at the time of Applicant's invention may have, in any way, predictably combined Gouge with Paul in the manner suggested by the Office Action, and such has not been adequately shown.

Second, to any extent that Gouge teaches allowing a system to retrieve user data profile to advertise a product, service or website which a user might be interested in, this is not a reasonable conclusion upon which to base the assertion that one of ordinary skill in the art would have predictably combined any of the teachings of the references as is suggested by the Office Action with any reasonable expectation of success in achieving the objectives which are intended to be achieved by, and in the manner of, the subject matter of the pending claims.

Third, even post-*KSR*, the analysis supporting an obviousness rejection must be explicit. The Supreme Court in *KSR* approved the conclusion set forth in the decision of the Federal Circuit in *In re Kahn* (citations omitted) that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." This standard is also not met here with the mere conclusory statement that one of ordinary skill in the art may have

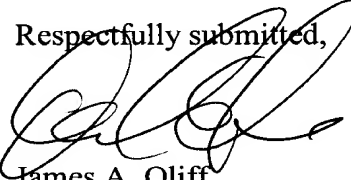
combined the secured identification method of Paul with the method of Gouge in the manner suggested. In other words, the articulated reasoning is flawed and, moreover, there is no rational underpinning to the articulated reasoning.

Fourth, MPEP §2143 is explicit its setting forth exemplary rationales to guide the obviousness analysis in supporting a rejection under 35 U.S.C. §103. The mandate of this MPEP section is that "[t]he key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." Not only is this standard ignored, but there is not even an attempt by the Office Action to frame the asserted obviousness rejection over this combination of applied references under any exemplary rationale set forth in the Patent Office's guidance to its Examiners.

For all of the above reasons, Paul and Gouge are not combinable in the manner suggested by the Office Action. Further, any permissible combination of Paul and Gouge cannot reasonably be considered to have suggested the combinations of all of the feature positively recited in independent claims 1 and 12. Further, claims 2, 3, 6, 8-11, 15 and 17-26 could also not have been suggested by this combination of references for at least the respective dependence of these claims, directly or indirectly, on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites. Accordingly, reconsideration and withdrawal of the rejection of claims 1-3, 6, 8-12, 15 and 17-26 under 35 U.S.C. §103(a) as being unpatentable over Paul in view of Gouge are respectfully requested.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-3, 6, 8-12, 15 and 17-26 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,

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